

REMARKS

In the present application, claims 26-49 are pending. Claims 26-49 are rejected.

Claim Rejection - 35 U.S.C. 103(a)

The Examiner has rejected claims 26-27, 32-35, 40-42 and 45-48 as being unpatentable under 35 U.S.C. 103(a) over Brosan (U.S. Patent No. 6,977,645), herein Brosan, in view of Tierling et al. (U.S. Patent No. 7,218,310), herein Tierling; claims 28, 36, 43 and 49 as being unpatentable under 35 U.S.C. 103(a) over Brosan in view of Tierling and further in view of Shearer et al. (U.S. Publication No. 2004/0203351), herein Shearer; claims 29, 38, 39 and 44 as being unpatentable under 35 U.S.C. 103(a) over Brosan in view of Tierling and further in view of Langford (U.S. Publication No. 2003/0083020), herein Langford; claims 30 and 37 as being unpatentable under 35 U.S.C. 103(a) over Brosan in view of Tierling and further in view of Fujitani et al. (U.S. Patent No. 7,170,618), herein Fujitani; and claim 31 as being unpatentable under 35 U.S.C. 103(a) over Brosan in view of Tierling and further in view of Fitzsimmons, JR. (U.S. Publication No. 2003/0175667), herein Fitzsimmons. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 26-49.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made¹.

¹ *In Re Fine*, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Regarding claim 26, which recites:

“A method comprising:
detecting a first tapping gesture on a surface of a device, where a tapping gesture comprises at least one directional component of three dimensional motion and at least one tap;
determining the at least **one directional component of the first tapping gesture**;
determining a number of taps of the first tapping gesture;
in response to detecting the first tapping gesture, providing a tactile feedback to confirm the first tapping gesture was detected, where the feedback is based upon the first tapping gesture; and
selecting a phone number based upon the first tapping gesture”
(emphasis added).

The Examiner asserts Brosan teaches:

“detecting a first tapping gesture on a surface of a device, where a tapping gesture comprises at least one directional component of three dimensional motion and at least one tap; (see Brosan, col. 2, lines 50-65)
determining the **at least one directional component** of the first tapping gesture; (see Brosan, col. 4, lines 45-50)
determining a number of taps of the first tapping gesture (see Brosan, col. 4, lines 45-50)
in response to detecting the first tapping gesture, providing a feedback to confirm the first tapping gesture was detected, where the feedback is based upon the first tapping gesture; (see Brosan, col. 4, lines 45-50) and
selecting a phone number based upon the first tapping gesture (see Brosan, col. 4, lines 45-50)” (emphasis added).

Consider the disclosure of Brosan:

“A user highlights a particular one of the menu items 18A-18C by moving highlight bar 16. In one embodiment, highlight bar 16 is moved by rubbing finger 22 against motion detection device 20. If finger 22 is moved upward against motion detection device 20, highlight bar 16 moves upward through menu items 18A-18C. If finger 22 is moved downward against motion detection device 20, highlight bar 16 moves downward through menu items 18A-18C. After a desired one of the menu items 18A-18C has been highlighted with highlight bar 16, the highlighted menu item is then selected. In one embodiment, a highlighted menu item is selected by moving finger 22 against motion detection device 20 in either a leftward or rightward direction. **After a highlighted menu item has been selected** by a user, cellular telephone 10A **automatically dials** the selected phone number, or the phone number associated with the selected name.

“In one embodiment, an alternative technique is **used to select highlighted menu items**, such as pushing a button on keypad 24 or tapping on motion detection device 20. However, when a user removes finger 22 from

motion detection device 20 to push one of pushbuttons 24 or **tap on motion detection device 20**, the user **may accidentally cause additional movement** across motion detection device 20, thereby causing a **different menu item to be selected**. By selecting menu items 18A-18C with rightward or leftward movement across motion detection device 20, the user need not remove the user's finger 22 from motion detection device 20 to select a desired menu item, which allows the user to select desired menu items more quickly and accurately" (col. 4, line 44 – col. 5, line 5, emphasis added).

As disclosed, "when a user removes finger 22 from motion detection device 20 to ... **tap on motion detection device 20**, the user **may accidentally cause additional movement** across motion detection device 20". This is described as a problem since do so may cause "a different menu item to be selected". In fact, Brosan teaches away from using a "tapping gesture" as in claim 26, so that "the user need not remove the user's finger 22 from motion detection device 20 to select a desired menu item, which allows the user to select desired menu items more quickly and accurately".

There is no disclosure or suggestion that "a number of taps of the first tapping gesture" is determined. The "number of taps of the first tapping gesture" does not appear relevant to Brosan. Clearly, Brosan does not disclose or suggest "determining a number of taps of the first tapping gesture" as in claim 26.

Tierling is not suggested as teaching this element of claim 26.

Furthermore, consider the additional disclosure of Brosan:

"Lifting fingertip 106 away from surface 105 by even a few thousandths of an inch defocuses the image and produces a loss of tracking. This condition is detected within motion detector 109, and in one embodiment, the production of incremental (X, Y) signals ceases. This has the effect of leaving highlight bar 16 unchanged at whatever location it currently occupies, and is exactly the same as when a user of a mouse removes his hand from the mouse. **When fingertip 106 is subsequently replaced** on surface 105, motion detector 109 **appreciates that an image has been acquired**, and, in one embodiment, treats that acquisition as though a reset has been performed. That is, **until there has been new motion subsequent to the new acquisition**, the incremental coordinates (X, Y) will have the value (0, 0)." (col. 6, line 58 – col. 7, line 9, emphasis added).

As disclosed, "until there has been new motion" "subsequent to the new acquisition" which occurs "When fingertip 106 is subsequently replaced on surface 105". Thus, it is motion that is applied after placing the fingertip on the surface that is used for "incremental

coordinates (X, Y)". Clearly, this is not analogous to "determining the at least one directional component of the first tapping gesture" as in claim 26.

Consider further that Brosan teaches that a "tap on motion detection device 20" "may accidentally cause additional movement". Thus, any "movement" detected would be an accidental by-product of the "tap on motion detection device 20". Clearly, Brosan does not disclose or suggest "determining the at least one directional component of the first tapping gesture" as in claim 26.

Tierling is not suggested as teaching this element of claim 26.

As neither Brosan nor Tierling disclose or suggest "determining the at least one directional component of the first tapping gesture" "determining a number of taps of the first tapping gesture" and "selecting a phone number based upon the first tapping gesture" as in claim 26, the combination of Brosan and Tierling (which the Applicants do not assert there is a motivation to so combine or that such a combination is feasible), herein Brosan-Tierling, also does not disclose or suggest these elements of claim 26. As Brosan-Tierling does not disclose or suggest all elements of claim 26, claim 26 is not made obvious by Brosan-Tierling. For at least this reason, claim 26 is in condition for allowance.

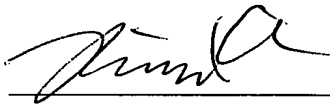
As claims 34, 41 and 47 recite similar language to that discussed above with reference to claim 26, claims 34, 41 and 47 are likewise in condition for allowance. As claims 27, 32-33, 35, 40, 42, 45-46 and 48 depend upon claims 26, 34, 41 and 47, they are likewise in condition for allowance.

As seen above, Brosan-Tierling does not disclose or suggest claims 26, 34, 41 and 47. As claims 26, 34, 41 and 47 are allowable over Brosan-Tierling then all claims that depend from claims 26, 34, 41 and 47 should also be allowable over Brosan-Tierling, whether considered alone or in combination with other art cited as applied by the Examiner. Further, the addition of the disclosures of Shearer, Langford, Fujitani and Fitzsimmons to Brosan-Tierling (without admitting that such combinations are suggested or technically feasible), would not cure the deficiencies in the disclosure of Brosan-Tierling. For at least this reason, claims 28-31, 36-39, 43-44 and 49 are in condition for allowance.

In light of the discussion above, the Applicant respectfully asserts that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 26-49.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

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